



HARD1.015A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Donald J. Merkley *et al.*
Appl. No. : 09/970,389
Filed : October 2, 2001
For : METHOD AND APPARATUS
FOR REDUCING IMPURITIES IN
CELLULOSE FIBERS FOR
MANUFACTURE OF FIBER
REINFORCED CEMENT
COMPOSITE MATERIALS
Examiner : Marc S. Alvo
Group Art Unit : 1731
Confirmation No. : 9683

DECLARATION UNDER 37 C.F.R. 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We, Donald J. Merkley and Caidian Luo, do hereby declare:

1. We are joint inventors of the above patent application, filed October 2, 2001.
2. U.S. Patent No. 6,030,447 (Naji *et al.*) forms a part of a rejection of claims 25–48 of the above application under 35 U.S.C. § 103(a). The rejection was made in a non-final Office Action mailed on March 1, 2005.
3. Naji *et al.* issued, and was first published, on February 29, 2000 from Application No. 08/910,466, filed July 25, 1997, which is a continuation of Application No. 08/545,527, filed October 19, 1995.
4. The facts described herein and the supporting documents filed herewith show reduction to practice and/or conception coupled with diligence prior to February 29, 2000 of the subject-matter described in claims 25–48.

Appl. No. : 09/970,389
Response filed on July 1, 2005
Responsive to an Office Action mailed March 1, 2005

5. EXHIBIT A is a monthly report by one of the inventors that includes descriptions of experiments concerning the subject-matter of claims 25-48. The monthly report is dated before February 29, 2000.

6. EXHIBIT B is a series of electronic mail messages between the inventors discussing experiments concerning the subject matter of claims 25-48. The electronic mail messages are dated before February 29, 2000.

7. The foregoing exhibits demonstrate reduction to practice and/or conception coupled with diligence for the subject matter of claims 25-48.

8. The work leading to the subject matter of claims 25-48 was conducted in the United States of America.

9. We declare that all statements made herein of our knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any patent issued thereon.

Dated: July 1, 2005

By: 
Donald J. Merkley

Dated: July 1, 2005

By: 
Caidian Luo

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ASSIGNMENT

WHEREAS, We, Donald J. Merkley, a United States citizen, residing at 5054 Klusman Avenue, Alta Loma, California 91737 and Caidian Luo, Chinese citizen, 10180 Northridge Drive, Alta Loma, California 91737, have invented certain new and useful improvements in a METHOD AND APPARATUS FOR REDUCING IMPURITIES IN CELLULOSE FIBERS FOR MANUFACTURE OF FIBER REINFORCED CEMENT COMPOSITE MATERIALS for which we have executed an application for Letters Patent in the United States, on even date herewith;

AND WHEREAS, James Hardie Research Pty Limited (hereinafter "ASSIGNEE"), an Australian Corporation, with its principal place of business at Level 1, Research and Product Development Building, 10 Colquhoun Street, Rosehill, NSW 2142, Australia, desires to acquire the entire right, title, and interest in and to the said improvements and the said Application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to me in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said inventors, do hereby acknowledge that we have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, his successors, legal representatives and assigns, the entire right, title, and interest throughout the world in, to and under the said improvements, and the said application and all provisional applications relating thereto, and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon and all reissues and extensions thereof, and all rights of priority under International Conventions and applications for Letters Patent which may hereafter be filed for said improvements in any country or countries foreign to the United States, and all Letters Patent which may be granted for said improvements in any country or countries foreign to the United States and all extensions, renewals and reissues thereof; and we hereby authorize and request the Commissioner of Patents of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents on applications as aforesaid, to issue all Letters Patent for said improvements to the said ASSIGNEE, his successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we will communicate to the said ASSIGNEE, his successors, legal representatives and assigns, any facts known to us respecting said improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the said ASSIGNEE, his successors, legal representatives and assigns, to obtain and enforce proper patent protection for said improvements in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 25 day of Sept, 2001,

Donald J. Merkley
Donald J. Merkley

Donald J. Merkley

STATE OF
California
COUNTY OF
SAN BERNARDINO

On 25 SEPT 2001, before me, VINCENT L CIRRITO, personally appeared Donald J. Merkley personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

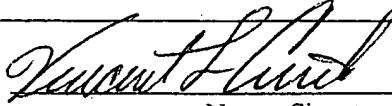
Application No.: Unknown
Filing Date: Herewith

PATENT

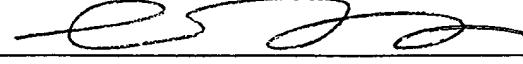
Client Code: HARD1.015A

Page 2

[SEAL]


Notary Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 25 day of September, 2001.


Caidian Luo

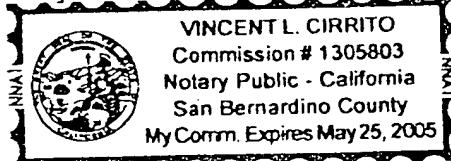
STATE OF
California
COUNTY OF
San Bernardino
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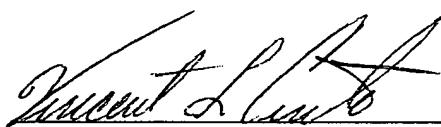
On 25 Sept 2001, before me, Vincent L. Cirrito, personally appeared Caidian Luo personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]



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Notary Signature



**James Hardie
Building Products**

A

Internal Memorandum

**James Hardie
Industries (USA) Inc.**

TO: Don Merkley

10901 Elm Avenue
Fontana, California 92337

FROM: Caidian Luo

Telephone 1-909-356-6300
1-800-426-4051
Fax 1-909-427-0634

DATE:

RE: Monthly Report for [REDACTED]

CC: Jay Lee, Rick Morales, and Jeannette Pacific

The jobs that I, with help from Jay Lee and Rick Morales, have accomplished in the month of [REDACTED] include but are not limited to:

A. [REDACTED]

B. For COD Experiment

- Designed an experimental plan to test the effect of hot water extractable COD on F-C products
- Extracted both LP and Tas████ pulp using hot water at 4% consistency, determined the COD in the extracts (results indicate that about 80 mg/L of COD was obtained in the hot water extracts)
- Made 12 sets of F-C pads using COD and tap water, and tested the physical properties of the pads (results show extractable COD has more negative effect on F-C board properties, and different pulps respond to COD water differently)
- Coordinated experiments of chemical analyses, extraction by hot water and sodium hydroxide, and pulp refining in tap water, ██████████
- ██████████
- Designed an experimental plan for further test of the effect of COD released during refining upon fiber-cement properties, if necessary

Caidian Luo

From: Don Merkley
Sent: [REDACTED]
To: Caidian Luo
Subject: RE: Hot Water Trial at [REDACTED]

How much of this material are we making? Did increasing the residence time mean that we had to make more?

—Original Message—

From: Caidian Luo
Sent: [REDACTED]
To: Don Merkley
Subject: Hot Water Trial at [REDACTED]

Dear Don:

We started the hot water washing trial from 1 o'clock today and will finish it by tomorrow. We increased the washing temp from 150 to 180F, and added three more washers in the washing system. Therefore, the residence time for washing increases from 6 hours to 12 hours. Hopefully this will remove most of "COD" substances from pulp.

It seems to me that LP people are willing to do this trial and to improve their pulp quality. We all are excited about the possible success of this trial. Vidas is here and he facilitated my work a lot.

If you have any instructions, please let me know. I will call you tomorrow afternoon as soon as I get some preliminary results on fiber properties. I really enjoy the opportunity you presented to me. I thank you so much for your full support so that I can put my research ideas into operations. I hope the results of this and other trials will significantly benefit James Hardie.

Thanks.

Caidian

7-5-05

Knobbe Martens Olson & Bear LLP

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Attorney Docket No. : HARD1.015A
Applicants : Donald J. Merkley et al.
For : METHOD AND APPARATUS FOR
REDUCING IMPURITIES IN CELLULOSE
FIBERS FOR MANUFACTURE OF FIBER
REINFORCED CEMENT COMPOSITE
MATERIALS
Attorney : Pui Tong Ho
"Express Mail" Label No. : EV 307 967 318 US
Date of Deposit : July 1, 2005

I hereby certify that the accompanying

Transmittal letter; Amendment in 7 pages with Exhibit 1; Declaration in 2 pages
with Exhibits A and B; Check for Filing Fee; Return Prepaid Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to
Addressee" service under 37 CFR 1.10 on the date indicated above and are addressed to the
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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